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08/957,187	10/24/97	BEER	E 514425-3566
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EXAMINER

AHMED, S

ART UNIT

PAPER NUMBER

1773

DATE MAILED:

05/01/00

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/957,187

Applicant(s)

Beer et al.

Examiner

Sheeba Ahmed

Group Art Unit

1773

☒ Responsive to communication(s) filed on Mar 6, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 10-23 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 10-23 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Response to Amendments

1. Amendments to claims 10-19 have been entered in the above-identified application.

Claim 9 has been canceled. New claims 20-23 have been introduced.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

2. Claims 10-14, 17-19, and 20-23 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Hirose et al. (US 5,532,030).

Hirose et al. disclose a multilayer laminate in which sheets or film based on polyolefins are laminated to form a material for packing. The multilayer laminate comprises a layer made from at least one cycloolefin-based resin selected from the group consisting of (a1) an ethylene/cycloolefin random copolymer obtained by polymerizing a cycloolefin (represented by the formula (1) or (2)) with ethylene, (a2) a ring-opening polymer of the cycloolefins or its hydrogenation product and (a3) a graft-modification product of (a1) or (a2) (Column 1, lines 13-16, 54-64 and Column 2, lines 1-5). The structure of the cycloolefin component is given in Column 2 wherein n may be zero or 1, m may be zero or any positive integer, q may be zero or 1 and the substituents R_1 - R_{18} may be a radical selected from the group consisting of hydrogen atom, halogen atom and

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hydrocarbon groups and wherein the R groups may form a monocyclic or polycyclic ring by combining with each other. The halogen atoms may be fluorine, chlorine, bromine or iodine and the hydrocarbon groups may be C₁-C₂₀ alkyl groups, C₁-C₂₀ halogenated alkyl groups, C₃-C₁₅ cycloalkyl groups and C₆-C₂₀ aromatic hydrocarbons (Column 4, lines 8-25). The ethylene/cycloolefin random copolymer usually contains the constituent unit derived from ethylene in an amount of 52-90 mole % and the constituent unit derived from a cycloolefin in an amount of 10-48 mole%. The ethylene/cycloolefin copolymer may contain constituent units derived from other copolymerizable monomers such as monocyclic olefins in an amount of 20 mole % or less (Column 21, lines 64-67, Column 22, lines 1-4, 66-67, Column 23, lines 31 and Column 24, lines 1-2). The cycloolefin-based resin may be blended with other resins and various additives (Column 29, lines 56-67). The multilayer laminate may be subjected to monoaxial or biaxial stretching to produce a sheet or film material suitable for packaging drugs, foods and cigarettes. Such a material has superior moisture-proof properties and therefore may be used as a blister pack, bottle or other type of container (Column 34, lines 33-67 and Column 35, lines 1-19). The thickness of the laminate is 100 microns as indicated in Table 1 in Columns 35 and 36. With regards to the limitations of the water vapor permeation, puncture resistance, film elongation at break, and film tear strength value in machine direction, the Examiner takes the position that these properties are inherent in the multilayer laminate disclosed by Hirose et al. given that the composition and structure of the laminate disclosed by Hirose et al. and the laminate of the claimed invention are

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identical. All limitations of the claimed invention are either inherent or disclosed in the above reference.

Claim Rejections - 35 USC § 103

3. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hirose et al. (US 5,532,030).

The above rejection is maintained for the reasons of record as set forth in paragraph No. 6 of the Office Action mailed on September 1, 1999 (Paper No. 7).

4. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hirose et al. (US 5,532,030) in view of Tanaka et al. (U.S. 5,556,920).

The above rejection is maintained for the reasons of record as set forth in paragraph No. 7 of the Office Action mailed on September 1, 1999 (Paper No. 7).

Response to Arguments

5. Applicant's arguments filed on March 6, 2000 have been fully considered but they are not persuasive.

Applicants traverse the above rejections and submit that the claimed invention possesses a specific set of properties, i.e., water permeation, puncture resistance and thickness, wherein the puncture resistance of the films is obtained by a selected processing of the film, and such

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properties or procedure to obtain such properties are neither disclosed nor obvious from the Hirose reference. Applicants further allege that if the correct stretching conditions are not chosen properly, the claimed puncture resistance is not achieved. However, the Examiner has taken the position that these properties are inherent in the multilayer laminate disclosed by Hirose et al. given that the composition and structure of the laminate disclosed by Hirose et al. and the laminate of the claimed invention are identical. Furthermore, Hirose specifically disclose that the thickness of the laminate may be 100 microns as indicated in Table 1 in Columns 35 and 36. Although, the Applicants allege that specific processing is required to obtain the necessary water permeation and puncture resistance, the Applicants have failed to provide any experimental data or other objective evidence to support the assertion that such processing leads to a materially different product than the one disclosed by Hirose. Thus, the Examiner maintains that the claimed water vapor permeation and puncture resistance are inherent properties of the laminate disclosed by Hirose.

Applicants further allege that Hirose only generally mentions that their films can be stretched mono- or biaxially and Hirose relates only to multilayer film whereas the present invention teaches and claims both mon- and multilayer films. First, the Examiner wishes to direct the Applicants attention to Columns 34 and 35 which *specifically state* that the multilayer laminate may be subjected to monoaxial or biaxial stretching to produce a sheet or film material suitable for packaging drugs, foods and cigarettes. Second, the Examiner would like to point out

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that the use of open-claim language in the claims of the instant application, i.e., *comprising*, does not preclude the presence of other layers or elements in the laminate.

Furthermore, it is unclear which rejection the Applicants are addressing when submitting that Hirose fails to provide either the desirability or modification required by Fine.

The provisional double patenting rejection of claims 9-14 under the judicially created doctrine of obviousness-type double patenting over claims 1 to 5 of copending application No. 08/994,863 is hereby withdrawn given that copending application No. 08/994,863 was expressly abandoned on December 30, 1999.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheeba Ahmed whose telephone number is (703) 305-0594. The Examiner can normally be reached on Monday-Friday from 8am to 5pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Paul Thibodeau, can be reached at (703) 308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5436.



Sheeba Ahmed
April 26, 2000



Paul Thibodeau
Supervisory Patent Examiner
Technology Center 1700